

In the outstanding Office Action, Claim 77 was rejected under 35 U.S.C. § 112, first paragraph, and Claims 52-124 were rejected under 35 U.S.C. § 103 as being obvious over U.S. Patent No. 5,123,089 (hereinafter “the ‘089 patent”), either alone or in combination with at least one other reference.

The paragraph crossing pages 9 and 10 has been amended to recite that email is transmitted using a protocol at the application layer. In the original paragraph crossing pages 9 and 10, the Stallings reference is incorporated by reference so that it does not constitute new matter to include what is described in Stallings into the present specification and to amend the claims to include this information. Independent claims 52, 76, 77 and 101 have been similarly amended to recite that the email is communicated using a protocol which is at an application layer.<sup>1</sup> As described more fully below, it is believed that this limitation is not taught by the applied references. Applicants also wish to bring to the attention of the examiner that this change is being made in light of the attached decision by the Board in a related case (U.S. Serial No. 08/738,461). While Applicants disagree with the decision of the Board, such a change is being made to expedite prosecution of this application. Additionally, the references cited in the Board’s decision are submitted herewith.

Applicants respectfully submit that the rejection of Claim 77 under 35 USC §112, first paragraph, is rendered moot by the amendment to Claim 77. Claim 77 now recites that the status information is stored in at least one memory. As this recitation is similar to non-rejected Claim 52, it is believed that this ground for rejection has been overcome. Thus,

---

<sup>1</sup> Exemplary email protocols which are at the application layer and are provided as non-limiting examples include SMTP (“Simple Mail Transfer Protocol”), POP protocols (“Post Office Protocols” such as Version 3 “POP3”), ESMTP (“Extended SMTP”), ADOP (“Authenticated POP”), IMAP (“Internet Message Access Protocol”), and MIME (“Multipurpose Internet Mail Extensions Protocol”).

Applicants submit that the original specification and drawings would enable one of ordinary skill to make and use the invention recited in Claim 77.

Claims 52-124 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the '089 patent, either alone or in combination with at least one other reference. Applicants respectfully traverse this rejection. First, Applicants request that the ground for rejection be clarified in a next Office Action. The Office Action asserts that the '089 patent teaches "a business office device (11-28) which is connected to a (sending) monitoring device 12 that monitors the business office device['s] response."<sup>2</sup> However, it is noted that the '089 patent does not disclose any device 11. Moreover, it appears that computer 12 would be considered both a business office device and a monitoring device under such an interpretation. This is no indication in the '089 patent that the computer 12 is self monitoring. Clarification is thus requested.

Assuming that the Office Action intended to cite units 24, 26 and 28 as business office devices, there is no teaching or suggestion in the '089 patent for the units 24, 26 and 28 to communicate with the computer 12 using an email protocol at an application layer. The '089 patent describes "Electronic mail is handled between the network controllers to allow data to be sent from one computer within the network to the other."<sup>3</sup> Similarly, col. 6, lines 16-24, cited by the Office Action, confirms the same thing ("Electronic mail is handled between the network controllers to allow data to be sent from one computer within the network to the other."). The '089 patent further clarifies that the "email" is between two network node controllers and not between a network node controller and a unit 24, 26 or 28. The specification expressly states "Consider now the operation of a network electronic mail

<sup>2</sup> Page 1, second paragraph of section 4.

<sup>3</sup> Abstract, lines 24-26.

session. A network mail session refers to communication that occurs when a network node controller with one ID sends a mail message to a network node controller with a different ID.”<sup>4</sup>

Thus, the alleged “email” is not between a business office device and a monitoring device, but rather between two computers 12, 14 and 16. Moreover, even if the communication was between a unit 24, 26 or 28 and one of the computers 12, 14, and 16, there is no indication that such communication in the ‘089 patent is at the application layer as claimed. Moreover, the Office Action does not assert, much less prove, that any of the other cited references overcome such a deficiency in the ‘089 patent. The Office Action therefore fails to establish a *prima facie* case of obviousness for the independent claims. Thus, the rejection of each of the independent claims should be withdrawn, and the rejection of the dependent claims should be withdrawn for at least the reasons set forth for the patentability of the independent claims from which they depend.

3 (3)

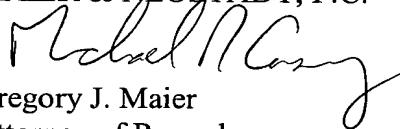
---

<sup>4</sup> Col. 12, lines 3-7.

Consequently, in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully submitted.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



Gregory J. Maier  
Attorney of Record  
Registration No. 25,599  
Michael R. Casey, Ph.D.  
Registration No. 40,294



**22850**

(703) 413-3000  
GJM:MRC:abs



244-0117-2X CONT

**Marked-Up Copy**

Serial No: 09/457,669  
Amendment Filed on: January 2, 2003

**IN THE SPECIFICATION**

The paragraph starting at page 9, line 12, has been amended as follows:

An important feature of the present invention is the use of a connectionless-mode of communication or transmission between a machine and a computer for diagnosing and controlling the machine. The IBM Dictionary of Computing by George McDaniel, 1994, defines a connectionless-mode transmission to be the transmission of a single unit of data from a source service access point to one or more destination service access points without establishing a connection. The IBM Dictionary also defines a connection-mode transmission to be the transmission of units of data from a source service access point to one or more destination service access points via a connection. The connection is established prior to data transfer and released following data transfer. Additional information about the connection-mode and the connectionless-mode of operation is described in the Handbook of Computer-Communication Standards, Vol. 1, 2nd Edition, by William Stallings, 1990, which is incorporated herein by reference. Stallings discloses that electronic mail is transmitted using a protocol which is at the application layer.

**IN THE CLAIMS**

Please amend claims 52, 76, 77 and 101 as follows:

52. (Amended) A[n] business office device which is connected to a monitoring device that monitors the business office device, the business office device comprising:

at least one memory for storing status information of the business office device; and  
an e-mail interface for transmitting, at an application layer, an e-mail containing a first portion of the status information to the monitoring device.

76. (Amended) A business system comprising:

a business office device; and

a monitoring device for monitoring the business office device from a remote location,

wherein the business office device includes (1) at least one memory for storing status information of the business office device, and (2) an e-mail interface for transmitting, at an application layer, an e-mail containing a first portion of the status information to the monitoring device.

77. (Amended) A monitoring method executed on a business office device, the method comprising:

storing[, internally,] status information of the business office device in at least one memory within the business office device; and

transmitting, at an application layer, an e-mail containing a first portion of the status information to a remotely located monitoring device.

101. (Amended) A computer program product, comprising:

a computer storage medium and a computer program code mechanism embedded in the computer storage medium for monitoring a business office device, the computer program code mechanism comprising:

a first computer code configured to store status information of the business office device in at least one memory; and

a second computer code configured to transmit, to a remotely located monitoring device and at an application layer, an e-mail containing a first portion of the status

information.